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REMARKS

Claims 1, 2, 5, 7-15, and 17-39 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments set forth below.

I. Rejection of Claims 8, 10, 11, and 12 Under 35 U.S.C. §103(a)

According to the current Office Action, the 35 U.S.C. § 103 rejection of claims 8, 10, 11, and 12 over Griffin *et al.* (4,696,706) in view of Cleef *et al.* (2,248,317) is repeated for reasons previously of record in paper #18, pages 4-5, paragraph #13. Withdrawal of the rejection is requested for at least the following reasons.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See MPEP §706.02(j).* Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See In re Vaeck*, 947 F.2d.488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 8 and 10-12 depend from claim 1. Claim 1 has previously been amended by clarifying a structural feature or shape limitation of the stack of leaves. In particular, the stack of leaves is of a size to conformally cover an entire exposed surface. In other words, the shape of the stack of leaves is such that it conformally covers an entire exposed surface.

Griffin *et al.* does not teach or suggest such an element. Rather, Griffin *et al.* merely describes the dispenser board 10 as being mounted on a chalk board, wall, or smooth surface. (col. 4, ll. 22-24). Thus, it is at least implicitly if not explicitly clear that the dispenser board is not of a size to conformally cover an entire exposed surface. Moreover, Griffin *et al.* does not teach or suggest each and every element of the claimed invention; and one of ordinary skill in the art would not have been motivated by the

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instant application to modify Griffin *et al.* in the claimed manner.

Cleef *et al.* is relied upon for its teaching of the leaves having an active agent and peeling means. Therefore, it is implicitly acknowledged that Cleef *et al.* also fails to teach or suggest the structural feature of the stack of leaves as discussed above. As with Griffin *et al.*, Cleef *et al.* merely describes a packet of stickers which when put into use, are individually pulled from the packet and applied to a surface. The packet itself is not applied or affixed to a surface. This is evidenced at least in col. 2, ll. 41-43, where Cleef *et al.* states that the bottom or lowermost sticker of the packet is protected from adhering to objects by way of a holland sheet. The holland sheet must be removed before applying the sticker to a surface. This is contrary to the present invention which requires that the stack of leaves is of a size to conformally cover an entire exposed surface. Hence, the present invention would not have been obvious to one of ordinary skill in the art at the time the invention was made in view of Griffin *et al.* and Cleef *et al.*, either individually or combined.

In view of the foregoing, the rejection should be withdrawn.

II. Rejection of Claims 13-15 Under 35 U.S.C. §103(a)

According to the current Office Action, the 35 U.S.C. § 103 rejection of claims 13-15 over Griffin *et al.* (4,696,706) in view of Cleef *et al.* (2,248,317) and further in view of Bowskill *et al.* (4,795,669) is repeated for reasons previously of record in paper #18, pages 5-6, paragraph #14. Withdrawal of the rejection is requested for at least the following reasons.

Claims 13-15 depend from claim 1 which has been previously amended as discussed above. The arguments set forth with respect to claims 8 and 10-12 apply herein as well. Thus, Griffin *et al.* and Cleef *et al.* fail to teach or suggest each and every element of the invention as claimed.

Bowskill *et al.* has been relied upon for its teaching of tabs comprising adhesive. Thus, it is implicitly acknowledged that Bowskill *et al.* also fails to teach and suggest that the stack of shields (in Bowskill *et al.*) are of a size to conformally cover an entire exposed surface, as required by the subject invention. In addition, Bowskill *et al.* fails to

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teach or suggest a base leaf underlying a first leaf, the first leaf having a first thickness, whereby the base leaf has a second thickness greater than the first thickness. Similar to at least Cleef *et al.*, Bowskill *et al.* involves a stack of shields which are individually removed from the stack to cover a surface. Again, this is contrary to the present invention which requires that the stack of leaves be of a size to conformally cover an entire exposed surface. In addition, Bowskill *et al.* fails to teach or suggest a base leaf. In fact, no mention of a base of the stack of shields is found in Bowskill *et al.* Hence, the present invention would not have been obvious to one of ordinary skill in the art at the time the invention was made in view of Griffin *et al.*, Cleef *et al.*, and Bowskill *et al.* either individually or combined.

In view of the foregoing, the rejection should be withdrawn.

III. Rejection of Claims 1, 2, 5, 6, 7, 9, 17, 18, 38, and 39 Under 35 U.S.C. § 103(a)

Claims 1, 2, 5, 6, 7, 9, 17, 18, 38, and 39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Griffin *et al.* (4,696,706). Withdrawal of the rejection is requested for at least the following reasons.

Claim 1 has previously been amended by clarifying a structural feature or shape limitation of the stack of leaves. In particular, the stack of leaves is of a size to conformally cover an entire exposed service. In other words, the shape of the stack of leaves is such that it conformally covers an entire exposed surface.

As previously stated above, Griffin *et al.* does not teach or suggest such an element. Rather, Griffin *et al.* merely describes the dispenser board 10 as being mounted on a chalk board, wall, or smooth surface. (col. 4, ll. 22-24). Thus, it is at least implicitly if not explicitly clear that the dispenser board is not of a size to conformally cover an entire exposed surface.

Furthermore, if a reference is cited that requires some modification in order to meet the claimed invention or requires some modification in order to be properly combined with another reference and such a modification destroys the purpose or function of the invention disclosed in the reference, one of ordinary skill in the art would not have found a reason to make the claimed modification. *In re Gordon*, 733 F.2d 900,

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221 USPQ 1125 (Fed. Cir. 1984). In the present case, the intended use of the logic symbols is explicitly demonstrated in Griffin *et al.*'s Fig. 3. As clearly illustrated in the figure, the logic symbols are individually applied non-conformally to a surface. That is, they are of a size that is intended to not conformally cover the whole or entire surface, but rather to provide a computer programmer or a logic designer a simple method of quickly and rapidly developing logic flowcharts or designs. More importantly, the dispenser board as shown in Figs. 1, 5, 6, and 7 of Griffin *et al.* is proportionate to the individual stickers or at least to all the different logic symbols (Fig. 1). Thus, modifying the size of the logic symbols and/or the size of the dispenser board to make it conformally cover an entire exposed surface would render the invention of Griffin *et al.* inoperable for its intended use for the fact that the dispenser board is applied or adhered to a chalkboard or wall and the individual symbols are meant to be applied to a surface for quick and rapid developing of flowcharts and designs. Therefore, the size of the dispenser board being modified to conformally cover a chalkboard or wall would be prohibitive of the intended use of the dispenser board, particularly in connection with the intended use of the logic symbols affixed thereto.

Granted, the size of the logic symbols can be varied according to the programmer's use, however their size in terms of conformally covering an exposed surface cannot be varied or modified or adjusted according to the entire exposed surface based on the teachings of Griffin *et al.* The present invention requires that the stack of leaves have a size that is conformal to an entire exposed surface. Griffin *et al.* does not teach or suggest such an element nor does Griffin *et al.* provide the requisite motivation to one of ordinary skill in the art to modify Griffin *et al.* in order to perform the subject invention.

As recited in claim 17, the stack of leaves is precut to the dimensions of a specific surface which further emphasizes that the stack of leaves has a size conformal to an entire exposed surface.

Thus, Griffin *et al.* does not teach or suggest each and every element of the claimed invention; and one of ordinary skill in the art would not have been motivated by the instant application to modify Griffin *et al.* in the claimed manner.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees for a **SMALL ENTITY** to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,
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